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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,160	06/21/2001	John Otto Piepenbrink	END920010038US1	5994
23550 7590 11/25/2008 HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207				
EXAMINER BROOKS, MATTHEW L				
ART UNIT		PAPER NUMBER		
3629				
NOTIFICATION DATE		DELIVERY MODE		
11/25/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

09/886,160

Applicant(s)

PIEPENBRINK ET AL.

Examiner

Matthew L. Brooks

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No./Mail Date: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flowchart of the process claims must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 1st

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There exist many problems with enablement that would require one of ordinary skill attempting to practice invention do conduct undue experimentation in order to practice use of said application/invention. The below are examples of components/limitations that are not enabled by the specification that can be applied to all of the claims where found.

4. As to "providing venture information" Applicant has stated the term with no definite scope as to include anything. Venture information submitted by one user may not be included in information submitted by another user. In fact there are limitless possibilities as to "venture information" could be. And for this reason alone one of ordinary skill would have to conduct undue experimentation to figure out what information is collected/ or is desired by user collecting said information. In fact experts

often fail in this process. Making the user of the software the actual inventor. Just as a person using an Excel spread sheet to conduct Applicants recording of data into rows and columns would be an inventor per se. The Dictionary definition of "venture" is attached... by definition it involves "uncertainty" and "speculation" both two things are of the nature that they are not concrete (see attached dictionary.com definition and 101 below).

5. As to "providing scoring data" there is no teaching of how to arrive at scoring data on the limitless possibilities of venture information that could be entered. For instance how would one "provide scoring data" on a business plan as found in claim 10? This would be left up to the subjective mind of the person considering joining the Venture. For examiner to figure out how to provide a scoring data to all of the venture information possibilities would require undue experimentation.

6. Also as to the analyzing a relationship and deploying one if positively evaluated. There is no framework and or teaching as to how or when to make the determination and employ the business relationship. And what a positive evaluation is and how determined and to do so would required undue experimentation.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. Certain considerations are applicable to analysis under either branch.

First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.

The present claims as a whole are directed toward managing information to allow a user to determine to enter a business venture. The claims although tied generally to a computer are not tied to any "particular" machine, so the use of the computer is considered extra-solution activity. So examiner must look to see if there is any transformation of a particular article. The only thing the claims attempt to change is that of the fundamental principle of entering a relationship.

"Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances."

Applicants' process at most incorporates only such ineligible transformations. . . . the process as claimed encompasses the entering of data onto any computer then

proposes to use this data to determine whether or not to enter a relationship. Yet the analyzing step as to whether to enter the relationship as demonstrated by claim 7, is powered by a human brain and is not claimed with any particular guidance. Thus, the claims does not have the muster to be patent eligible.

The claims are also rejected under Ex parte Bilski's analysis of 101. This is in that because the term "venture information" can be read to be so broad that it covers (preempts) any and every possible way that the steps may encompass, both known and unknown. Further it may be so broad that it covers both statutory and nonstatutory subject matter (In re Musgrave, 431 F.2d at 893).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0014373 (Perge) in further view of US 2001/0023477 A1 (Jarske). Note: due to the numerosity of claims and the repetitiveness thereof the most comprehensive claim 9 was examined for purposes of this action and its dependents up to 13.

Claim 9 is rejected under 35 U.S.C. 103 as being unpatentable over the Perge in view of Jarske. The Perge reference discloses all of the informational features normally provided to a venture company considering entering a relationship (Figs 2 and 3). Further Perge discloses that the questionnaire/information provided automatically populates a pre-scripted narrative form that is available to download or access electronically that may also be subject to a rating system which in turn can be used to evaluate potential investment/venture opportunities (Fig 3 "goodness-of-fit"). Perge does not discuss the type of database used and or how the data stored in it is searched or queried in the manner claimed by Applicants.

However Jarske teaches copying first memory rows into second memory rows which is achieved with parallel memory updating, by copying a row from the first memory to a row in the second memory. The rows in the first memory are old (not updated) and the rows formed in the second memory are new (updated). [0012] Jarske also teaches that this method of updating is faster and eliminates trace back. [0008] Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the row/column updating method taught by Jarske to store and access the data in one's database in a typical venture evaluation system such as that taught in Perge for the purpose of obtaining account information. The desirability to do

this is clearly to save a time and eliminate trace back while providing the most up to date information at the time of query.

Response to Arguments

11. Applicant's arguments with respect to the claims have been considered but are not persuasive and addressed.

12. IT should first be noted that Examiner never got a response to the 105 request originally made. Summarized briefly by Applicants last response dated In response to bottom of page 16, what does the following statement mean: "Applicants respectfully submit that they in particular are not aware of such a database?" Is this to say that all the parties IBM and the inventors and the attorneys have never heard of (i) a column – row matrix of records or (ii) when queried duplicating single record form a first column to a second column of row (essentially a function on an X-cel(tm) spreadsheet? Also the 105 issued specifically asked/bolded what is this an improvement on and for pertinent technical information known to Applicant (whomever that may be).

Examiner fails to be convinced that the attorney, IBM as an organization, or the inventors have no pertinent information in relation to the aforementioned questions.

Appropriate action in response is requested.

13. In reply to: bottom of page 16; examiner completely disagrees with Applicant assertion. Drawings with a flow chart of the invention will truly facilitate an understanding of the claimed method steps in addition to the fact that statute requires drawings must show every feature of the invention specified in the claims (see above).

14. In reply to : page 17; Applicant's assertion that "...the preamble to the claims pertain to the *managing of information for establishing a relationship with a venture company*." This language still does not limit the rows and columns to anything certain. This is clearly demonstrated in 112 first paragraph rejection made above. The Dictionary definition of "venture" is attached... by definition it involves "uncertainty" and "speculation" both two things are of the nature that they are not concrete (see attached dictionary.com definition and 112 and 101 above). And all though the specification does indeed describe vaguely some examples of what venture information may be, it certainly is not found within the claims nor is it taught anywhere within the specification quantifying things such as "business plan" for entry into a column row matrix. With respect to Applicant's assertion of where these type of calculations are taught/shown Examiner has searched pages 17-19 of original filed specification and can find no such teachings.

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB
11/07/08

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629

Application Number**Application/Control No.**

09/886,160

**Applicant(s)/Patent under
Reexamination**

PIEPENBRINK ET AL.

Examiner

Matthew L. Brooks

Art Unit

3629